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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,885	04/30/2001	Manuel Gonzalez	60006756-1	1164

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EXAMINER

BRIER, JEFFERY A

ART UNIT

PAPER NUMBER

2672

DATE MAILED: 02/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/843,885	GONZALEZ ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jeffery A. Brier	2672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 08 November 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,4-16 and 24-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1, 4-16, and 24-39 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

1. The examiner in charge of examining this application has changed to Primary Examiner Jeffery A. Brier.

***Response to Amendment***

2. The amendment filed on 11/08/2004 has been entered. The amendments to claims 1, 11-16, 24, and 29 overcomes the objection to these claims.

***Response to Arguments***

3. Applicant's arguments, see page 10, filed 11/08/2004, with respect to the objection of claims 27 and 28 have been fully considered and are persuasive. Applicants comments concerning claims 27 and 28 are correct and the objection of those claims is withdrawn.

4. Applicant's arguments concerning the 35 USC 103 rejection filed 11/08/2004 have been fully considered but they are not persuasive. Applicant contends on page 15 lines 12-21 that the objects in Oberg are preexisting and thus generally do not need to be printed. However, Oberg explicitly teaches printing the computer generated composite of the artwork with the matte and frame at column 3 lines 63-67, column 4 lines 40-50, and column 7 lines 9-13. Thus, Oberg teaches the need to print the finished composited image to allow the user to view the composited image. Therefore, Oberg does not teach away from the addition of Sakai's large scale printer since Oberg shows in figure 3 artwork 68 which is large and which would require a large printer to

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print an image of the artwork composited with images of a user selected matte and a user selected frame. At column 3 line 66 and column 7 line 12 Oberg uses the words "image of the order" to refer to the print of the artwork composited with images of a user selected matte and a user selected frame which matte and frame are of a size corresponding to the size of the artwork. The words "image of the order" manifests to one of ordinary skill in the art at least a print that will show the image clearly to the user which inherently includes a print large enough to convey the image of the order. Thus, Oberg suggests to one of ordinary skill in the art a print that is large enough to clearly see the "image of the order" which includes large prints if in fact Oberg does not actually teach using a large printer to the skill artisan. Therefore, the combination of Sakai with Oberg has proper motivation.

The change in size of the printer is also obvious because of legal precedent.

See MPEP 2144.04IV which states:

A. Changes in Size/Proportion

In re Rose , 220 F.2d 459, 105 USPQ 237 (CCPA 1955) (Claims directed to a lumber package "of appreciable size and weight requiring handling by a lift truck" where held unpatentable over prior art lumber packages which could be lifted by hand because limitations relating to the size of the package were not sufficient to patentably distinguish over the prior art.); In re Rinehart, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) ("mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled." 531 F.2d at 1053, 189 USPQ at 148.).

In Gardner v. TEC Systems, Inc., 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Thus, in view of the legal precedents the use of a large scale printer to print large scale prints that are of the actual intended size would have been obvious to one of ordinary skill in the art. Also to make prints large enough to view the "image of the order" is also taught by this legal precedent. Additionally the claimed "large format dimensions" do not have relative significance in the claim and is also covered by legal precedence. See MPEP 2173.05(b).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 4-16, and 24-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,870,771 to Oberg and further in view of US Patent 6,088,138 to Sakai et al. (hereafter "Sakai"). The rejection from the previous rejection mailed on 8/6/2004 is substantially reproduced below with regards to claims 1, 4-16, and 24-35 with modification made to the motivation.

Regarding independent claim 1, Oberg disclose in Fig. 1 and in col. 4 lines 35-64 a system comprising input means (ref. # 20 in Fig. 1) for providing input into the system which is connected to a microprocessor (ref. # 22 in Fig. 1) in which the software program (ref. # 26 in Fig. 1) is loaded. The software program loaded on microprocessor is for controlling the input/output means, image processing and

analysis, database retrieval and storage. The microprocessor (ref. # 22 in Fig. 1) is connected to one or more output means (ref. # 24 in Fig. 1) which may include a displaying monitor, a printer, storage device or any other peripheral devices able to receive the output from the system.

Oberg disclose in col. 3 lines 43-44 that the system and program allow the modification to the image and also disclose in col. 6 lines 1-5 that attributes like size or color of the image may be modified, and further disclose in col. 7 line 62-64 that the system allows the updated image to be viewed and displayed.

Although Oberg disclose outputting the image to the printer or other forms of peripheral devices but he does not explicitly disclose a large format printer.

On the other hand, Sakai disclose in col. 12 lines 54-59 and Figs. 1A and 1B a color printer with two cassette trays 735 and 736, and two kinds of recording paper set in the respective cassette trays which are A4-size recording paper set in the upper cassette tray 735 and A3-size recording paper set in the lower cassette tray 735.

It would have been obvious to an ordinary skilled in the art at the time of invention to combine the large format printer of Sakai to the system of Oberg to print images of variable sizes including large-scale images at the user's request in very short time for user's convenience. Additional motivation is as discussed above in the response to argument that Oberg suggests using a large printer and because of the legal precedent discussed above in the response to arguments.

Regarding dependent claim 4 "the system according to claim 1, wherein said terminal enables the selection of a mounting background for projecting with said selected image." Oberg disclose in col. 3 lines 38-67 "*The image can be modified if desired. There are various display screens that allow the customer to input a request to the system to analyze the color composition of the input and supply images of color-coordinated items, to search the database for coordinating products, to change the configuration of the framing products, and to output data to various output devices. The system is capable of creating a composite visual concept of a customer's order and allows the customer to adjust the color, size, width and other characteristics of frames and matting materials until the desired combination is achieved.*" Selecting a mounting background could be one of the customer' input for projecting with selected image.

Claims 5-7 are similar in scope to claim 4 and therefore are rejected under the same rational.

Regarding dependent claim 8, Oberg disclose in col. 4 lines 50-54 a software program for controlling the input means and the output means, for image processing and analysis, for database retrieval and storage, and for inventory and accounting functions which is loaded into memory in the microprocessor. Oberg further disclose in col. 3 lines 54-64 a program for providing different information like color analysis, coordinating products, and etc to user.

Regarding dependent claim 9, Oberg disclose in col. 4 line 43 and in col. 3 lines 63-67a printer for printing the finished image (selected image).

Regarding dependent claim 10, Oberg disclose in col. 4 line 43 and in col. 3 lines 63-67outputting the image to a printer or other forms of peripheral devices but he does not explicitly disclose a large format printer. On the other hand, Sakai disclose in col. 12 lines 54-59 and Figs. 1A and 1B a color printer with two cassette trays 735 and 736, and two kinds of recording paper set in the respective cassette trays which are A4-size recording paper set in the upper cassette tray 735 and A3-size recording paper set in the lower cassette tray 735.

It would have been obvious to an ordinary skilled in the art at the time of invention to combine the large format printer of Sakai to the system of Oberg to print images of variable sizes including large-scale images at the user's request in very short time for user's convenience.

Claims 11-16 recite method steps performed by the system of claims 1-10; therefore they are similar in scope and rejected under the same rationale.

Claims 24-35 recite apparatus for performing the methods claims 11-16; therefore they are similar in scope and rejected under the same rationale.

Claims 36-38:

These claims correspond to method claim 11 and further means claim 38 is taught by the means the combination of Oberg and Sakai and claims 36-38 are rejected for the reasons given for claim 1.

Claim 39:

This apparatus claim corresponds to system claim 1 and it is rejected for the reasons given for claim 1.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claim 38 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement because it is a single means claim. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. A single means for performing the many steps of claim 36 has not been disclosed by applicant's patent application. MPEP 2164.08(a) states:

2164.08(a) Single Means Claim

A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. *In re Hyatt*, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to *Hyatt* is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor.

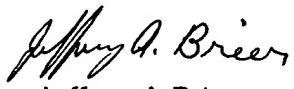
9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A Brier whose telephone number is (571) 272-7656. The examiner can normally be reached on M-F from 7:00 to 3:30. If attempts to

reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi, can be reached at (571) 272-7664. The fax phone Number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffery A Brier  
Primary Examiner  
Art Unit 2672